

REMARKS/ARGUMENTS

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the amendments and remarks herewith, which place the application into condition for allowance. The present amendment is being made to facilitate prosecution of the application.

I. STATUS OF THE CLAIMS AND FORMAL MATTERS

Claims 1-12, 25-29 are pending. Claim 29 is hereby added. Claims 1, 10, 25, 27 and 29 are independent. No new matter has been introduced. Support for this amendment is provided throughout the Specification as originally filed.

II. REJECTIONS UNDER 35 U.S.C. §103(a)

Claims 1, 10 and 25 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 6,020,982 to Yamauchi et al. (hereinafter, merely Yamauchi) in view of U.S. Patent No. 5,590,306 to Watanabe et al. (hereinafter, merely Watanabe). Applicant respectfully traverses this rejection.

Claim 25 is representative and recites, *inter alia*:

“ . . . judging means for judging whether an inserted memory card is copyright-protected when a normal response is obtained within a predetermined period of time during an authorization process;

. . . recording means temporarily records said copyright-unprotected contents to said first memory card for a predetermined period of time; and

. . . controlling means automatically transfers the recorded copyright-unprotected contents from said first memory card to the inserted second memory card,

wherein, in response to an instruction to eject the first memory card, the controlling means causes erasure of the copyright-unprotected contents from the first memory card.” (emphases added)

In part, the present invention is an apparatus (and method) used for two purposes: as a recorder recording copyright-protected content and as a recorder recording copyright-unprotected content to a memory card.

Claim 25 is illustrative and claims the recording of copyright-unprotected content to a memory card when only a copyright-protected memory card is inserted in the apparatus. In this case, the data are recorded to the copyright-protected memory card. When the apparatus detects that a copyright-unprotected memory card is inserted, the unprotected contents are automatically transferred to the unprotected memory card. When the apparatus is instructed to eject the protected memory card, the apparatus automatically erases the unprotected contents from the protected memory card.

New claim 29 recites substantially the same elements as discussed above in relation to claim 25. Applicant asserts two points to distinguish the elements recited in the present application from the cited art of Yamauchi and Watanabe.

A. A First Distinguishing Characteristic

Claim 25 recites, “judging whether an inserted memory card is copyright-protected . . . recording means temporarily records said copyright-unprotected contents to said first memory card . . . transfers the recorded copyright-unprotected contents from said first memory card to the inserted second memory card.”

Thus, the claims recites judging means that distinguishes between the types of memory card inserted, not the data on the memory card or whether there is a memory card inserted. If the type of card is copyright protected then the device records copyright unprotected content to the memory card. Hence, unprotected content are recorded to a copyright protected memory card.

If a second memory card that is copyright unprotected is later inserted, the unprotected content is automatically transferred (without user intervention) to the unprotected card from the copyright protected card.

The Office Action asserts that Yamauchi determines whether a memory card is inserted. However, there is no suggestion that Yamauchi distinguishes between the types of memory card inserted.

Regarding Watanabe, it is asserted in the Office Action that Watanabe discloses status bits indicating a status of the data in the packet (write, read and copy protected). FIG. 5. The status bits only allow certain usage of the data in the packet. The Office Action cites column 9, lines 39-47 for the element of judging if a card is copy protected or copy unprotected and whether the data is on a particular card.

However, at the referenced location, Watanabe states, “bit D6 a write protect bit indicating that any data are prohibited from being written into the IC memory card 4; the bit D5 a read protect bit indicating that any data are prohibited from being read out from the IC memory card 4; the bit D4 a copy protect bit indicating that the IC memory card 4 is prohibited from being copied . . .” Thus, the status bits of Watanabe prevent writing to a write-protected packet whereas in the present application copyright-unprotected content is written to a copyright-protected memory card. Further, the present application recites that the content also is transferred (*i.e.*, copied and arguably read, as well) from a copyright-protected card to a

copyright-unprotected card, which would not be allowed by Watanabe for copy protected content.

Thus, neither Yamauchi nor Watanabe either alone or in combination teach or suggest the recording of copyright-unprotected content to a copyright-protected memory card and then transferring the unprotected content to an unprotected memory card. The references do not teach or suggest a first memory card is copyright-protected and a second memory card is copyright-unprotected and, “records said copyright-unprotected contents to said first memory card . . . transfers the recorded copyright-unprotected contents from said first memory card to the inserted second memory card” as recited in claim 25.

For reasons similar to or somewhat similar to those described above with regard to independent claim 25, independent claims 1, 10, 27 and 29 are also believed to be patentable.

B. A Second Distinguishing Characteristic

Claim 25 recites, “in response to an instruction to eject the first memory card, the controlling means causes erasure of the copyright-unprotected contents from the first memory card.” Thus, the copyright-unprotected content is erased from the copyright-protected memory card in response to an instruction to eject the copyright-protected card.

Watanabe and Yamauchi each suggest erasure of content when requested by a user. However, there is no suggestion in either Watanabe or Yamauchi that content is erased in response to an instruction to eject the memory card.

The automatic erasure of the copyright-unprotected content from the copyright-protected memory card has the advantage that memory space on the copyright-protected card is “freed up”

for later recording of copyright-protected content. The recorded copyright-unprotected content does not remain on the copyright-protected card after the card is ejected. That is, the present apparatus has the advantage of preserving space on copyright-protected memory cards for a new use over less expensive copyright-unprotected memory cards.

Neither Yamauchi nor Watanabe discloses, teaches, or suggests each and every element recited in claim 25. In particular, the references do not teach or suggest a first memory card is copyright-protected and a second memory card is copyright-unprotected and, “in response to an instruction to eject the first memory card, the controlling means causes erasure of the copyright-unprotected contents from the first memory card” as recited in claim 25.

For reasons similar to or somewhat similar to those described above with regard to independent claim 25, independent claims 1, 10, 27 and 29 are also believed to be patentable.

III. CLAIMS 5 AND 6

Applicants challenge the factual assertion as Not Properly Officially Noticed
or not Properly Based Upon Common Knowledge.

From the MPEP 2144.03(E): “Any rejection based on assertions that a fact is well-known or is common knowledge in the art without documentary evidence to support the examiner’s conclusion should be judiciously applied. Furthermore, as noted by the court in *Ahlert*, any facts so noticed should be of notorious character and serve only to ‘fill in the gaps’ in an insubstantial manner which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection. *See, for example, In re Zurko*, 258 F.3d 1379, 1386; *In re Ahlert*, 424 F.2d 1088, 1092.”

Further, “[a]s noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be ‘capable of such instant and unquestionable demonstration as to defy dispute.’ (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).” MPEP 2144.03.

The Office Action asserts, without support, “[t]he Examiner takes Official Notice that is well known in the art to produce copyrighted material a software application would be used and thereby the software can be produced privately and independent form the apparatus.”

Applicants contend that this is a mere conclusory statement and an impermissible reliance on Official Notice. The Applicants contend this is not of notorious character nor insubstantial. Certainly, the features recited in claims 5 and 6 are not capable of “instant and unquestionable demonstration as to defy dispute.” These features are neither “basic knowledge” nor “common sense.” *In re Lee*, 277 F.3d 1338, 1345 (Fed. Cir. 2002) (“Deficiencies of the cited references cannot be remedied by the Board's general conclusions about what is ‘basic knowledge’ or ‘common sense.’”). Applicants contend that claims 5 and 6 recite substantive features that can not be overcome with Official Notice.

IV. DEPENDENT CLAIMS

The other claims are dependent from one of the independent claims, discussed above, and are therefore believed patentable for at least the same reasons. Because each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

CONCLUSION

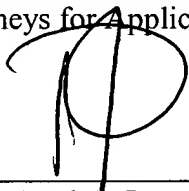
In the event the Examiner disagrees with any of statements appearing above with respect to the disclosure in the cited reference or references, it is respectfully requested that the Examiner specifically indicate those portions of the reference, or references, providing the basis for a contrary view.

Please charge any additional fees that may be needed, and credit any overpayment, to our Deposit Account No. 50-0320.

In view of the foregoing amendments and remarks, it is believed that all of the claims in this application are patentable and Applicant respectfully requests early passage to issue of the present application.

Respectfully submitted,

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